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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,841	09/30/2002	Susanne Brakmann	B1180/20005	5272

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EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,841

Applicant(s)

BRAKMANN ET AL.

Examiner

Dwayne K. Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,22-24 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,22-24 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 17-21, 22-24 and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (4,266,920) in view of Elkins (4,441,793) and further in view of Muramatsu et al. (6,645,434). This rejection was originally applied to claim 23. It now applies to claims 17-20, 22-24 and 29-36 in light of Applicant's amendment that adds the limitation of claim 23 (the base thickness) to claim 17 and new claims 34-36. As for the new limitation in claim 17, the Examiner notes that glass is inert under reaction conditions.
3. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (4,266,920), Elkins (4,441,793), Muramatsu et al. (6,645,434) and further in

view of Brown (6,037,168). This rejection was previously applied to claim 27 and 28 without the Muramatsu reference. It remains in effect. Please see Response to Arguments below.

Response to Arguments

4. Applicant's arguments filed 4/19/07 have been fully considered but they are not persuasive. Applicant has argued the following in traversing the rejections made by the Examiner (1) The cover glass of Muramatsu is too large; and (2) One of ordinary skill in the art would not be motivated to combine Muramatsu with the other art. The Examiner respectfully disagrees on both counts.

(1) Cover glass thickness

Applicant has argued that the glass of Muramatsu is too thick to meet the claimed limitation. The Examiner disagrees and takes the position that "nearly 0.17 mm" (170 μ m) meets the limitation of "about 150 μ m" or "150 μ m" as recited by Applicant in claims 17 and 36. The Examiner further notes that the base of the instant device appears to derive its thickness from the fact that it is a "flat glass plate of a thickness corresponding to a thickness of cover glasses for use in microscopy (about 150 μ m) – see page 14, lines 8-10; and page 16, lines 27-28. That is, Applicant appears to simply be using a microscopy cover glass as the base. The Examiner submits that this is what Muramatsu teaches. Muramatsu recites use of a glass plate – usually a cover glass having a thickness of nearly 0.17 mm – as the base plate column 2, lines 12-13 and 53-

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62). Therefore, the Examiner fails to see how the "cover glass" used in the microscopy system of Muramatsu is different from the choice of a "cover glass for use in microscopy" used by Applicant.

(2) Motivation to add Muramatsu

Applicant has also argued that one would not be motivated to combine because one of ordinary skill in the art would not expect one would not expect glass plates to be used as reaction substrates subjected to mechanical load. Applicant then refers to paragraph 2 on page 11 of the Specification as an example of unintended results. The Examiner respectfully disagrees and submits that this paragraph appears to be silent as to mechanical strength provided by the base thickness and instead teaches that the reaction substrate is well suited to high sample throughput **due to the fact that time-intensive readjusting of the microscope is not required**. As stated in a previous Office Action (mailed 6/14/05), the motivation to combine the glass having the thickness of Muramatsu is because it allows for examination of the slide by various types of microscopes as taught in Muramatsu (column 2 lines 63-67).

Conclusion

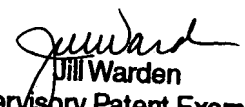
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH
June 22, 2007


Jill Warden
Supervisory Patent Examiner
Technology Center 1700